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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,390	10/30/2001	Yoshifumi Tanimoto	81800.0169	2154

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EXAMINER

HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/020,390

Applicant(s)

TANIMOTO, YOSHIFUMI

Examiner

Peter K. Huntsinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/01, 1/05, 3/05</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

2. Figure 7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claims 17 and 18 are objected to because of the following informalities: In claim 17, the phrase "the image dada has" should be replaced with "the image data has". In claim 18, the phrase "approval of transmittion" should be changed to "approval of transmission". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 7, 10, 11, 13, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naylor et al. U.S. Patent 6,625,642 and Staples et al. U.S. Patent 6,301,339.

Referring to claims 1 and 10, Naylor et al. disclose a gateway device comprising (server 30 of Fig. 1, col. 8, lines 35-43): means for connecting with each of a public switched telephone network (PSTN 29 of Fig. 1, col. 7, lines 38-42), and a computer communication network (LAN, col. 8-9, lines 66-67, 1); means for determining which network is to be used based on identifying information (destination identifier, col. 2, lines 59-66), when receiving image data and the identifying information of a destination of the image data from a facsimile machine (step 404 of Fig. 4, col. 11, lines 1-3); and means for transmitting the image data to the determined network (col. 8, lines 39-43). The server of Naylor is considered a gateway device because it joins together two networks (PSTN and LAN). Naylor et al. do not disclose expressly a facsimile device connected to a private exchanging network. Staples et al. disclose a facsimile device connected to a private exchanging network (Fig. 30, col. 54, lines 53-60). Naylor et al. and Staples et al. are combinable because they are from the same field of facsimile communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the

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art to provide the gateway device with private branch exchanging function and to allow connecting a facsimile device through a private exchanging network to the gateway device. The motivation for doing so would have been to allow a user to utilize an existing PBX network without requiring a public phone line for the facsimile device. Therefore, it would have been obvious to combine Staples et al. with Naylor et al. to obtain the invention as specified in claims 1 and 10.

Referring to claim 7, Naylor et al. disclose the gateway device with private branch exchanging function according to claim 1 further comprising: means for carrying out the transmission of the image data to the computer communication network in electronic mail format communication by SMTP (Simple Mail Transfer Protocol) (col. 7, lines 6-10).

Referring to claim 11, Naylor et al. disclose the gateway device with private branch exchanging function according to claim 10 further comprising: means for receiving image data from the facsimile machine (step 404 of Fig. 4, col. 11, lines 1-3), accumulating the received image data when the means for determining determines that the computer communication network is to be used, and then transmitting the image data to the computer communication network (step 416 of Fig. 4, col. 11, lines 22-25).

Referring to claim 13, Naylor et al. disclose the gateway device with private branch exchanging function according to claim 11 further including: means for acquiring an IP address of another gateway device located in an area related to the destination, based on the identifying information when the computer communication network is to be used, wherein the image data is transmitted to the another gateway device. It is inherent that a URL is needed to obtain the IP address using the email address

provided by the server. Without a URL providing the IP address, the server would have no way of knowing where to send the message.

Referring to claim 16, Naylor et al. disclose a method of transmitting image data comprising the steps of: (A) receiving image data and information of a destination of the image data from a facsimile machine (step 404 of Fig. 4, col. 11, lines 1-3); (B) determining which network of a public switched telephone network and a computer communication network is to be used (destination identifier, col. 2, lines 59-66); and (C) transmitting the image data to the network determined in step (B) (col. 8, lines 39-43). Naylor et al. do not disclose expressly a facsimile device connected to a private exchanging network. Staples et al. disclose a facsimile device connected to a private exchanging network (Fig. 30, col. 54, lines 53-60). Naylor et al. and Staples et al. are combinable because they are from the same field of facsimile communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide the gateway device with private branch exchanging function and to allow connecting a facsimile device through a private exchanging network to the gateway device. The motivation for doing so would have been to allow a user to utilize an existing PBX network without requiring a public phone line for the facsimile device. Therefore, it would have been obvious to combine Staples et al. with Naylor et al. to obtain the invention as specified in claim 16.

Referring to claim 20, Naylor et al. disclose the method according to claim 16 wherein when the network determined in step (B) is the computer network, the

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transmission of the image data is carried out in electronic mail format communication by SMTP (Simple Mail Transfer Protocol) in step (C) (col. 7, lines 6-10).

6. Claims 2, 3, 8, 9, 14, 15, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naylor et al. U.S. Patent 6,625,642 and Staples et al. U.S. Patent 6,301,339 as applied to claims 1 and 10 above, and further in view of Ho et al. U.S. Patent 5,805,298.

Referring to claim 2, Naylor et al. disclose a gateway device but do not disclose expressly judging whether the transmission has been completed or not. Ho et al. disclose means for judging whether or not the transmission of the image data to the computer communication network has been completed (314 of Fig. 3, col. 7, lines 37-41); and retransmitting means for retransmitting the image data to the public switched telephone network when the means for judging judges that the transmission has not been completed (col. 7, lines 37-41). Ho et al. disclose that if an internet connection cannot be enabled, a new connection can be initiated. It would be obvious for the user to initialize the new transmission utilizing a facsimile communication because if a connection to the internet could not be enabled before, it is highly likely that the connection still could not be enabled. Naylor et al. and Ho et al. are combinable because they are from the same field of facsimile and email communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to retransmit a message through PSTN when an internet connection cannot be enabled. The motivation for doing so would have been to allow the message to reach the

destination if the internet connection is down. Therefore, it would have been obvious to combine Ho et al. with Naylor et al. to obtain the invention as specified in claim 2.

Referring to claim 3, Ho et al. disclose wherein the retransmitting means makes confirmation of carrying out the transmission of the image data to the public switched telephone network with the facsimile machine, and transmits or does not transmit the image data to the public switched telephone network based on a result of the confirmation (col. 7, lines 37-41). The user is able to provide the command of whether to retransmit the message or can choose not to issue the command.

Referring to claims 8 and 9, Naylor et al. disclose means for carrying out the transmission of the image data to the computer communication network in electronic mail format communication by SMTP (Simple Mail Transfer Protocol) (col. 7, lines 6-10).

Referring to claim 14, Naylor et al. disclose a gateway device but do not disclose expressly judging whether the transmission has been completed or not. Ho et al. disclose means for judging whether or not the transmission of the image data to the computer communication network has been completed (314 of Fig. 3, col. 7, lines 37-41). Naylor et al. and Ho et al. are combinable because they are from the same field of facsimile and email communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to retransmit a message through PSTN when an internet connection cannot be enabled. The motivation for doing so would have been to allow the message to reach the destination if the internet connection is down. Therefore, it would have been obvious to combine Ho et al. with Naylor et al. to obtain the invention as specified in claim 14.

Referring to claim 15, Ho et al. disclose means for making confirmation of carrying out retransmission of the image data with the facsimile machine when the means for judging judges that the transmission of the image data to the computer communication network has not been completed (col. 7, lines 37-41); and retransmitting means for retransmitting the image data to the public switched telephone network when a result of the confirmation is approval of the retransmission. (col. 7, lines 37-41). Ho et al. disclose that if an internet connection cannot be enabled, a new connection can be initiated. It would be obvious for the user to initialize the new transmission utilizing a facsimile communication because if a connection to the internet could not be enabled before, it is highly likely that the connection still could not be enabled.

Referring to claim 17, Naylor et al. disclose a gateway device but do not disclose expressly judging whether the transmission has been completed or not. Ho et al. disclose the step of (D) judging whether or not transmission of the image data has been completed when the image data is transmitted to the computer network in step (C) completed (314 of Fig. 3, col. 7, lines 37-41). Naylor et al. and Ho et al. are combinable because they are from the same field of facsimile and email communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to retransmit a message through PSTN when an internet connection cannot be enabled. The motivation for doing so would have been to allow the message to reach the destination if the internet connection is down. Therefore, it would have been obvious to combine Ho et al. with Naylor et al. to obtain the invention as specified in claim 17.

Referring to claim 18, Ho et al. disclose the steps of: (E) asking the facsimile machine whether or not retransmission of the image data to the public switched telephone network is to be carried out when in step (D) (col. 7, lines 37-41), it is judged that the transmission of the image data has not been completed; and retransmitting the image data to the public switched telephone network when a result of asking in step (E) is approval of retransmission (col. 7, lines 37-41). Ho et al. disclose that if an internet connection cannot be enabled, a new connection can be initiated. It would be obvious for the user to initialize the new transmission utilizing a facsimile communication because if a connection to the internet could not be enabled before, it is highly likely that the connection still could not be enabled.

7. Claims 4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naylor et al. U.S. Patent 6,625,642 and Staples et al. U.S. Patent 6,301,339 as applied to claim 1 above, and further in view of applicant's admitted prior art.

Referring to claims 4 and 19, Naylor et al. disclose the gateway device of claim 1, but do not disclose expressly transmitting the image data by T.83 protocol. The applicant's admitted prior art discloses carrying out the transmission of the image data to the computer communication network in real time communication by T.83 protocol (page 2, paragraph 4). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to transmit image data utilizing the T.83 protocol. The motivation would have been to allow sending real time faxes over IP transports.

8. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naylor et al. U.S. Patent 6,625,642, Staples et al. U.S. Patent 6,301,339, and Ho et al. U.S. Patent 5,805,298 as applied to claims 2 and 3 above, and further in view of applicant's admitted prior art.

Referring to claims 5 and 6, Naylor et al. disclose a gateway device, but do not disclose expressly transmitting the image data by T.83 protocol. The applicant's admitted prior art discloses carrying out the transmission of the image data to the computer communication network in real time communication by T.83 protocol (page 2, paragraph 4). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to transmit image data utilizing the T.83 protocol. The motivation would have been to allow sending real time faxes over IP transports.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Naylor et al. U.S. Patent 6,625,642 and Staples et al. U.S. Patent 6,301,339 as applied to claim 10 above, and further in view of Antognini et al. US Publication 2204/0218226.

Referring to claim 12, Naylor et al. disclose the gateway device with private branch exchanging function according to claim 10, wherein the means for connecting, connects the facsimile machine to the public switched telephone network (step 614 of Fig. 6, col. 12, lines 3-4) when the means for determining determines that the public switched telephone network is to be used (step 610 of Fig. 6, col. 11-12, lines 66-67, 1-3). Naylor do not disclose expressly connecting a facsimile machine to a private branch network. Staples et al. disclose a facsimile device connected to a private exchanging

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network (Fig. 30, col. 54, lines 53-60). Antognini et al. disclose connecting the facsimile machine to the other facsimile machines when the means for determining determines that the message is designated for a facsimile machine (Fig. 1, page 4, paragraph 43). It would be obvious for the facsimile machines of Antognini et al. to be connected to the fax server utilizing a private branch network as taught by Staples et al. Staples et al. and Antognini et al. are combinable because they are from the same field of facsimile communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow connecting facsimile devices through a private exchanging network. The motivation for doing so would have been to allow a user to utilize an existing PBX network without requiring public phone lines for the facsimile devices. Naylor et al. and Antognini et al. are combinable because they are from the same field of facsimile communication. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to connect a plurality of facsimile machines to a server. The motivation for doing so would have been to allow a plurality of facsimile devices to send data through the internet or PSTN instead of just one device. Therefore, it would have been obvious to combine Antognini et al. with Naylor et al. and Staples et al. to obtain the invention as specified in claim 12.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH



KING Y. POON  
PRIMARY EXAMINER